Election / #10
5/28/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 028622/0103

In re patent application of:

Ernst Peter RIEBER

Serial No.: 09/700,200 Group Art Unit: 1644

Filed: January 23, 2000 Examiner: G. Ewoldt

For: ANTIBODIES TO DENDRITIC CELLS AND HUMAN DENDRITIC CELL POPULATIONS AND USES THEREOF

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the restriction requirement provided by the Examiner on March 20, 2002, Applicant hereby provisionally elects Group I, Claims 1-6, 8-11, 16, 17 and 46 with traverse. Enclosed is a petition for a one-month extension of time to extend the time to respond to May 20, 2002, and the requisite fee. If the petition or fee is deficient or absent, please consider this paragraph a request for the extension of time and an authorization to withdraw the appropriate fee under from Deposit Account No. 19-0741.

The Examiner separated the claims of the invention into twenty allegedly different separate groups. The basis for this restriction requirement is that the claims do not contain a single general inventive concept under PCT Rule 13.2 because WO 93/04187 teaches an antibody which reacts with an epitope on dendritic cells (DCs) but does not react with peripheral blood mononuclear cells (PBMCs) citing page 2. Applicant respectfully disagrees with the Examiner's position because the referenced portion of WO 93/04187 does not disclose that the antibody, MRC OX-62, does not react with PBMCs, as is required by the claims. Thus, there is no basis to for the Examiner's *a priori* holding of lack of novelty based on this patent document. The Examiner is asked to reconsider his position on this issue.

Pursuant to MPEP § 1850, in PCT national phase cases, (§371 cases) the Examiner is required to follow the determination of the International Bureau and cannot *sua sponte*, set

forth his or her own groupings for purposes of examination. For example, *Caterpillar Tractor Co. v Commissioner of Patents*, 650 F.Supp. 218, 231 USPQ 590 (VA 1986).

The standards of restriction practice for PCT applications entering the national stage in the United States Patent & Trademark Office, as is the present application, are governed by 37 CFR §§ 1.475 and 1.499. The present application contains claims to all three categories of product, process of making and process of use, and pursuant to 37 CFR § 1.475 (b), an international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:...(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product;..." This category applies to the present application, and in view of this patent rule, it is requested that claim 30 (Group VII) directed to a method of isolating or identifying DCs using the elected antibody, or alternatively, claim 57 (Group XX) to the extent that it is directed to a method of using the elected antibody in the method of modulating the immune response be included with the claims of Group I and examined on the merits.

Likewise, applicant requests reconsideration of the kit claims 41-43 and 45 of Group XIII to the extent that it comprises the antibody of Group I, and the polypeptide claims 12, 18-25, 46 and 47 of Group V to the extent that it comprises a domain of a binding site of the antibody of claim 1. If Group V is joined with Group I, then applicant requests that the polynucleotide (Group VI, claims 26-29) encoding the domain of a binding site of the elected antibody of Group I be examined. It is believed that the subject matter of the claims of Groups V and VI are sufficiently related to be examined together, and such examination would not place an undue burden on the Examiner. When the nucleic acid is searched, the amino acid sequence of PAK5 is also searched. MPEP 803 recites that if "the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

In regard to the election of Group I, with traverse, applicants respectfully disagree with the Examiner's rationale for requiring restriction between the antibody of Group I and the bispecific antibody of Group II. The bispecific antibody of Group II has the same characteristic of the antibody of Group I in that it reacts with the epitope on DCs but not with PBMCs, in addition to also recognizing an epitope that is specific for other cells. When a search is performed for the antibody that recognizes the epitope on DCs as claimed in Group

I, this same property of the bispecific antibody of Group II also is searched. MPEP 803 applies as above.

Applicants, of course, reserve the right to file one or more divisional applications covering the subject matter of the non-elected claims. Examination on the merits is kindly requested.

Respectfully submitted,

May 20, 2002
Date

Jayme A. Huleatt
Reg. No. 34,485

FOLEY & LARDNER
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5109
Phone: (202) 672-5300
Fax: (202) 672-5399